

PATENTS

UNITED STATES PATENT AND TRADEMARK OFFICE

Application:	09/829,863	Examiner:	Truong, Cam Y T
Filed:	04/10/2001	Art Unit:	2162
Inventor:	Mindrum, G. Scott	Atty Ref.:	0103085 - 0515558
Title:	METHODS OF PROVIDING A REGISTRY SERVICE AND A REGISTRY SERVICE		

PRE-APPEAL BRIEF**(in accordance with 1296 Off. Gaz. Pat. Office 67 (July 12, 2005))**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Office Action dated 08/02/2006 contains clearly improper rejections based on several clear errors in facts and law, and it contains omissions of essential elements needed for a *prima facie* case of obviousness to support the rejections issued in the Office Action. These errors and omissions will be addressed with respect to each of the pending independent claims.

§101 Rejection of Claim 21:

Claim 21 was rejected as reciting subject matter that is not tied to a technological art, and for failing to contain hardware or a computer that is used to produce a tangible, concrete, useful result. As an initial matter, Applicant notes that this rejection appears to impermissibly apply a “technological arts test.” The Board of Patent Appeals and Interferences (BPAI) explicitly rejected the existence of such a test in the precedential opinion of *Ex Parte Lundgren*. (BPAI Appeal No. 2003-2088, for App. No. 08/093,516, Paper No. 78 (2005)). Accordingly, to the extent that it applies the clearly rejected “technological arts test,” the Examiner’s §101 rejection of claim 21 is based on clear error in law.

Furthermore, Applicant notes that claim 21 recites, among other things, “a **concrete** memorial” (emphasis added), “an on-line registry service accessible over the Internet,” and “an identifier on or near the concrete memorial.” The claimed system would be properly considered as a “machine” and/or “manufacture” under §101. The result of the claimed system is an on-line registry service and an identifier on or near a **concrete** memorial for a deceased person, with the identifier indicating to people visiting the **concrete** memorial that information related to the deceased person is available on the on-line registry service. Clearly, this result is concrete, useful, and tangible - particularly if a “final share price” can be properly regarded as a concrete, useful, and tangible result. (*See State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368 (Fed.Cir. 1998)). The Examiner’s §101 rejection of claim 21 is therefore based on clear error in facts.

§101 Rejection of Claim 43:

To the extent that it applies the clearly rejected “technological arts test,” and for the reasons set forth above with respect to the §101 rejection of claim 21, the Examiner’s §101 rejection of claim 43 is based on clear error in law.

Applicant further notes that claim 43 recites, among other things, “a **concrete** memorial” (emphasis added), “an on-line registry service accessible over the Internet,” and “a seal on or near the concrete memorial.” The result of the claimed system is an on-line registry service and a seal on or near a **concrete** memorial for a deceased person, with the seal indicating to people visiting the **concrete** memorial that information related to the deceased person is available on the on-line registry service. As noted above with respect to the similar result provided by the system recited in claim 21, this result is clearly concrete, useful, and tangible - particularly if a “final share price” can be properly regarded as a concrete, useful, and tangible result. (*See State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368 (Fed.Cir. 1998)). The Examiner’s §101 rejection of claim 43 is therefore based on clear error in facts.

§103 Rejection of Claim 21:

Claim 21 recites “an identifier on or near the concrete memorial for the deceased person, the identifier indicating to people visiting the concrete memorial that the information related to the deceased person is available on the on-line registry service.” In the pending Office Action,

the Examiner purported to find this element in screenshots from the Arlington National Cemetery website (hereinafter “ANC screenshots”). The ANC screenshots include images of headstones, and a biographical entry for a deceased person. Without admitting that the ANC screenshots properly constitute prior art, Applicant submits that the ANC screenshots clearly fail to teach the above-quoted limitation of claim 21 in its entirety. Applicant further submits that the Examiner’s suggestion that a deceased person’s name, as taught by the ANC screenshots, constitutes an “identifier” *indicating to people visiting the concrete memorial that information related to the deceased person is available on an on-line registry service*, is a clear error in fact. To the extent that a deceased person’s name constitutes some sort of “identifier” in the ANC screenshots, it is not taught in the ANC screenshots as “indicating to people visiting the concrete memorial that the information related to the deceased person is available on the on-line registry service,” as recited in claim 21. Ultimately, even in combination, the cited references clearly fail to teach or even remotely suggest the above-quoted limitation of claim 21. The Examiner’s argument that the art teaches the above-quoted limitation of claim 21 therefore constitutes clear error in facts.

Furthermore, because the Examiner has otherwise failed to show how the above-quoted limitation of claim 21 is taught or suggested by the combined art of record, the Examiner has clearly failed to establish a *prima facie* case of obviousness in accordance with MPEP 2143.03. In other words, the rejection contains a clear omission of an essential element needed for the *prima facie* obviousness rejection issued in the Office Action – the essential element required by MPEP 2143.03.

§103 Rejection of Claim 36:

Claim 36 includes the limitation “visually indicating, on or near the physical memorial for the deceased person, that the on-line registry service is associated with the deceased person.” In purporting to find this limitation in the prior art, the Examiner broke this limitation into two parts: (1) visually indicating, on or near the physical memorial for the deceased person, and (2) that the on-line registry service is associated with the deceased person. The Examiner then purported to find part (1) on page 1 of the ANC screenshots, and failed to cite any portion of the prior art allegedly teaching part (2). Applicant submits that breaking the limitation apart in such a way is impermissible and clearly erroneous. Similar to the absence of a teaching in the

combined prior art of the “identifier” limitations discussed above with respect to claim 21, the Examiner has failed to establish a teaching in the combined prior art of the above-quoted limitation from claim 36. In other words, even in combination, the cited references fail to teach or even remotely suggest visually indicating on or near a physical memorial for a deceased person that an on-line registry service is associated with the deceased person, as recited in claim 36. The Examiner’s argument that the combination teaches this limitation constitutes clear error in facts.

Furthermore, because the Examiner has otherwise failed to show how the above-quoted limitation of claim 36 is taught or suggested by the combined art of record, the Examiner has clearly failed to establish a *prima facie* case of obviousness in accordance with MPEP 2143.03. In other words, the rejection contains a clear omission of an essential element needed for the *prima facie* obviousness rejection issued in the Office Action – the essential element required by MPEP 2143.03.

§103 Rejection of Claim 43:

Claim 43 includes the limitation “a seal on or near the concrete memorial for said deceased person, the seal indicating to people visiting the concrete memorial in the cemetery that the biographical data related to said deceased person is available on the on-line registry service.” In purporting to find this limitation in the prior art, the Examiner relied again on pages 1-7 of the ANC screenshots. The ANC screenshots include images of headstones, a biographical entry for a deceased person, and nothing more. Without admitting that the ANC screenshots properly constitute prior art, Applicant submits that the ANC screenshots clearly fail to teach the above-quoted limitation of claim 43 in its entirety. In particular, nothing shown in the ANC screenshots constitutes a “seal” *indicating to people visiting the concrete memorial in the cemetery that biographical data related to the deceased person is available on an on-line registry service*. Ultimately, even in combination, the cited references clearly fail to teach or even remotely suggest the above-quoted limitation of claim 43. The Examiner’s argument that the art teaches the above-quoted limitation of claim 43 therefore constitutes clear error in facts.

Furthermore, because the Examiner has otherwise failed to show how the above-quoted limitation of claim 43 is taught or suggested by the combined art of record, the Examiner has clearly failed to establish a *prima facie* case of obviousness in accordance with MPEP 2143.03.

In other words, the rejection contains a clear omission of an essential element needed for the *prima facie* obviousness rejection issued in the Office Action – the essential element required by MPEP 2143.03.

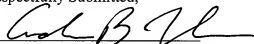
Conclusion:

Applicant notes that the dependent claims add other limitations that further distinguish over the cited references, providing additional bases for patentability. The dependent claims also satisfy the standards imposed under §101 for at least the same reasons that their respective independent claims satisfy the standards imposed under §101.

Applicant further notes that the Office has had more than ample opportunity to conduct a vigorous prior art search and examination on the claims of this application, yet the Office has failed to render any reasonable rejections. In particular, Applicant notes that two Requests for Continued Examination (RCE's) have been filed, and that this application has already been subject to a first Pre-Appeal Brief Conference, with substantially similar subject matter being claimed since the first RCE was filed on 02/27/2004. The subsequent rejections have had no more merit than the prior rejections. Accordingly, Applicant submits that the Pre-Appeal Brief Conference Panel should allow this case instead of simply re-opening prosecution.

In view of the foregoing, Applicant respectfully requests that the Pre-Appeal Brief Conference Panel withdraw the Examiner's rejections of all of the claims on appeal, and that the pending claims be allowed in due course. Applicant reserves all rights and arguments with respect to those claimed features issues not expressly discussed above. Should this submission not comply with the submission requirements, or if the Panel has any outstanding issues to be addressed, the Applicant invites the Panel to contact the undersigned at (513) 369-4811, or at aulmer@fbtlaw.com.

Respectfully Submitted,



Andrew B. Ulmer (Reg. No. 57,003)
Frost Brown Todd LLC
2500 PNC Center
201 East Fifth Street
Cincinnati, Ohio 45202-4182
513-369-4811 (direct)